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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CRAIG L. REDING, ZIAUDDIN MAJID,
and SHASHI NEELAKANTAN

Appeal 2009-002590
Application 10/720,825
Technology Center 2600

Decided: September 29, 2009

Before MAHSHID D. SAADAT, KARL D. EASTHOM,
and ELENi MANTIS MERCADER, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1-7, 9, 10, 12, 13, 16, and 17. Claims 8, 11, 14, and 15 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellants' invention relates to routing an SMS message that is intended to be sent to any of the user's communication devices, to a user's preferred communication device. (Spec. ¶¶ [009] – [010].)

Claim 1 is illustrative of the claimed invention and reads as follows:

1. A method for providing SMS messages to a receiving party associated with a plurality of devices, the method comprising:

receiving a[n] SMS message for a first device of the plurality of devices;

identifying a second device of the plurality of devices as a preferred device instead of the first device for receiving the SMS message based on information stored by the receiving party;

formatting the SMS message according to characteristics of the preferred device; and

sending the formatted message to the preferred device.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Karve	US 2002/0137530 A1	Sep. 26, 2002
Fostick	US 2002/0187794 A1	Dec. 12, 2002

Packham	US 2003/0055906 A1	Mar. 20, 2003
Sabo	US 2003/0096626 A1	May 22, 2003
Gopinath	US 2004/0002350 A1	Jan. 1, 2004 (filed Jun. 26, 2002)
Dehlin	US 2004/0203942 A1	Oct. 14, 2004 (filed May 6, 2002)

Claims 1, 2, 6, 9, 10, 12, 13, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as being obvious over Karve and Packham.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being obvious over Karve, Packham, and Gopinath.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being obvious over Karve, Packham, and Dehlin.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being obvious over Karve, Packham, and Sabo.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being obvious over Karve, Packham, and Fostick.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

Rejection over Karve and Packham

With respect to the rejection of claim 1, Appellants argue (App. Br. 7-8) that the system resulting from the combination proposed by the Examiner receives an SMS message and forwards it to another device, which is different from the claimed step of identifying a second device instead of the first device for receiving the SMS message. Appellants further contend that the combination is improper since the intended function of Karve becomes meaningless if the reference is combined with Packham and the user turns off the cellular phone (App. Br. 9-11).

Appellants provide similar arguments for claims 9, 12, 16, and 17 (App. Br. 11-17, 19-24, 26-29) and further assert that the database for storing information identifying first and second device, a gateway server for receiving an SMS message, a server function for identifying the preferred device, and an SMS server for sending the message, as recited in claim 9, are not taught by the combination (App. Br. 11-14).

Additionally, regarding claims 10 and 13, Appellants argue that the SMS server in Karve is configured to store messages to a database only when the preferred device is not available (App. Br. 17-19, 24-26).

Appellants' arguments present the following first, second, and third issues:

1. Have Appellants shown that the Examiner erred in rejecting claim 1 by finding that combining Karve and Packham is proper and, if so, does the combination meet the claimed feature of identifying a second device instead of the first device for receiving the SMS message?

2. Have Appellants shown that the Examiner erred in rejecting claim 9 by finding that combining Karve and Packham is proper and, if so, does the combination meet the claimed features of a database for storing information identifying first and second device, a gateway server for receiving an SMS message, a server function for identifying the preferred device, and an SMS server for sending the message?

3. Have Appellants shown that the Examiner erred in rejecting claim 10 by finding that combining Karve and Packham is proper and, if so, does the combination meet the claimed feature of storing messages to a database when the preferred device is not available?

Rejections over Karve and Packham, in view of Gopinath or Fostick

With respect to the rejections of claims 3 and 7, Appellants merely rely on the arguments made with respect to claim 1 and assert that the teachings of Gopinath or Fostick in combination with Karve and Packham fail to teach or suggest the recited features of these claims (App. Br. 30, 35).

Rejection over Karve, Packham, and Dehlin

Appellants argue that the disclosure of Dehlin does not include sending the formatted message to a preferred device, as recited in claim 4 (App. Br. 30-33). Appellants' arguments present the following fourth issue:

4. Have Appellants shown that the Examiner erred in rejecting claim 4 by finding that combining Dehlin with Karve and Packham is proper and, if so, does the combination meet the claimed feature of sending the formatted message to a an instant messenger client?

Rejection over Karve, Packham, and Sabo

Appellants argue that combining Sabo with the teachings of Karve and Packham to achieve the stated benefit in rejecting claim 5 is merely

based on conclusory statements and constitutes hindsight (App. Br. 33-35). Appellants' arguments present the following fifth issue:

5. Have Appellants shown that the Examiner erred in rejecting claim 5 by finding that combining Sabo with Karve and Packham is proper and, if so, does the combination meet the claimed feature of sending the formatted message as a voice message to a phone?

FINDINGS OF FACT

The following findings of fact (FF) are relevant to the issues involved in the appeal.

Karve

1. Karve discloses a mobile communications device that supports Short Message Service (SMS) and includes a means for receiving an SMS short message and program code for forwarding the received short message from the mobile communications device to another device. (¶ [0015].)

2. The device includes a database memory for storing at least one predefined forwarding address and a controller connected to the database for accessing a predefined forwarding address. (¶ [0016].)

3. As shown in Figure 3, the program code also offers an option to forward the received message at step 42 based on a list of forwarding addresses displayed on the display 12 and previously added to the list by the user. The user may scroll through the list and select, add, or specify one or more of the numbers to which the message is to be forwarded via the SMS center. (¶ [0032].)

4. By appropriate programming at the SMS center or by allowing the user to define forwarding address lists stored at the SMS center, Karve

provides for sending the message once to the SMS center, with the header portion of the message identifying a pointer to multiple destination addresses stored in a memory at the SMS center. (§§ [0028], [0033].)

5. Karve shows in Figure 4 that all messages are automatically forwarded to a predefined number as defined by the user. (§ [0035].)

6. Karve further discloses that SMS is a store and forward service, which means that messages are sent via an SMS center which handles and manages the short messages. (§ [0007].)

Packham

7. Packham sends text messages intended for a first terminal to a second terminal by sending a control signal from the first terminal to routing circuitry indicating that text messages intended for the first terminal are to be forwarded to the second terminal. (§ [0004].)

8. As shown in Figure 1, a short message service centre SMSC forwards a text message from a first user terminal to a short message service Gateway mobile switching centre SMS/GMSC. An added function identifies a text message and the forwarding information so as to give updated (i.e., rerouted) routing information for sending the text message via the mobile switching centre MSC to the correct user terminal. (§ [0019].)

Dehlin

9. Dehlin uses a customized SMS message based on an instant message transmitted by a sender to awaken the mobile device and initiate instant messaging (IM). The mobile device may respond by transmitting a reply customized SMS message to the sender. (Abstract; § [0013].)

10. Dehlin provides for an IM server and an IM/SMS server for providing the instant messaging service and to alert the mobile device of an incoming instant message. (¶¶ [0026] – [0027].)

Sabo

11. Sabo discloses that, if a landline telephone is the final destination for an SMS message, the message may be translated to a voice message using a text-to-speech translator and the text message may be transmitted as a voice message. (¶¶ [0013], [0031].)

PRINCIPLES OF LAW

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *See In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006); *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). The initial burden of establishing reasons for unpatentability rests on the Examiner. *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992).

The Examiner can satisfy this burden by showing “‘some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *Kahn*, 441 F.3d at 988). “‘The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.’” *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR*, 550 U.S. at 416). “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which

there was an obvious solution encompassed by the patent's claims.” *KSR*, 550 U.S. at 419-20.

ANALYSIS

35 U.S.C. § 103 Rejection over Karve and Packham

1. Claim 1

Based on our review of Karve, we find that the forwarding option in Karve meets the claimed step of “identifying a second device . . . instead of the first device . . . based on information stored by the receiving party.” As stated by the Examiner (Ans. 13), the mobile communication device in Karve automatically forwards the SMS message to a predefined number which is stored and defined by the user (FF 1, 5). We also disagree with Appellants (App. Br. 7-8) that Karve does not disclose the claimed “identifying a second device . . . as a preferred device instead of the first device” since the user in Karve actually does define the alternate device or number instead of the user’s telephone (FF 2-5). We observe that the claim merely requires identifying a second device instead of the first device and, therefore, does not preclude sending the message to a first device, which gets forwarded to a second device as the ultimate destination.

Additionally, contrary to Appellants’ arguments (App. Br. 9) that combining Packham with Karve would make the system in Karve meaningless if its user turns off the telephone, the messages in Karve are forwarded by the SMS center (FF 3-4). While the user in Karve defines the forwarding options (FF 3-4), such information is stored either in the device database (FF 2) or in the SMS center (FF 4). As such, even if the user turns the telephone off, the message intended for the user’s device will be

forwarded to the destination via the SMS center (FF 3) based on the predefined number entered and defined by the user (FF 4-5).

Therefore, as asserted by the Examiner (Ans. 14-15), combining the details of rerouting a message in Packham (FF 7-8) with Karve would provide alternate, obvious ways to perform the known function of rerouting an SMS message. According to the *KSR* standard, the combination of Karve and Packham provides an obvious solution for a known problem, without teaching away from Karve or rendering it meaningless. Therefore, we find that Appellants have not shown that the Examiner erred in rejecting claim 1 by properly combining Karve and Packham to meet the claimed feature of identifying a second device instead of the first device for receiving the SMS message.

2. *Claim 9*

The Examiner relies on the SMS center in Karve and asserts that the address list stored in the center is a database for storing information identifying the devices (Ans. 17). We agree and find that the system disclosed by Karve does include a database memory for storing information to identify the forwarding addresses of other devices (FF 2-3) wherein the stored list may be at the SMS center and used to forward the message via the SMS center (FF 4). We also find that the Examiner has properly characterized the SMS center of Karve as the gateway server and the SMS server having the claimed server functions.

Because the information regarding other devices are stored in a database in the SMS server and the functions of receiving of the message and forwarding it to the alternate destination are preformed “via the SMS center” (FF 3-5), the disputed claimed features are met by the SMS center of

Karve. Thus, Appellants have not shown that the Examiner erred in rejecting claim 9 by finding that the combination of Karve and Packham properly meets the claimed features of a database for storing information identifying first and second device, a gateway server for receiving an SMS message, a server function for identifying the preferred device, and an SMS server for sending the message.

3. *Claim 10*

Appellants argue (App. Br. 18-19) that Karve does not disclose that an SMS server is configured to store messages to a database when the preferred device is not available. By relying on paragraph [0007] of Karve, the Examiner points out (Ans. 18-19) that the SMS center, which is disclosed as a store and forward service, stores the messages.

We remain unpersuaded by Appellants' arguments since Karve describes the SMS service as one that stores and forwards messages (FF 6). As such, the SMS center stores the messages that are to be forwarded to the preferred device via the SMS center (FF 3-5). Therefore, the store and forward function of the SMS center meets the requirement of claim 10 since the message is stored in a database and remains in the database when the preferred device is not available to receive the message. Thus, we find that Appellants have shown no error in the Examiner's rejection of claim 10 based on finding that Karve and Packham suggest the claimed feature of storing messages to a database when the preferred device is not available.

35 U.S.C. § 103 Rejections over Karve and Packham, in view of Gopinath or Fostick

Based on similar arguments provided for claims 3 and 7 (App. Br. 30, 35) and for the same reasons discussed above with respect to claim 1, we also find no error in the Examiner's rejection of these claims.

35 U.S.C. § 103 Rejection over Karve, Packham, and Dehlin

Appellants argue that the disclosure of Dehlin does not include sending the formatted message to an instant messenger client, as recited in claim 4 (App. Br. 30-33). The Examiner responds (Ans. 21) by relying on the Abstract of Dehlin teaching that the formatted message is sent to an instant messenger client. After reviewing Dehlin, we agree with the Examiner's line of reasoning that Dehlin's use of the SMS service to alert an instant messenger client (FF 9-10) indicates that the recipient of the SMS message is an instant messenger client. Therefore, we find that Appellants have not shown that the Examiner erred in rejecting claim 4 by combining Dehlin with Karve and Packham to suggest the claimed feature of sending the formatted message to a preferred device that is an instant messenger client.

35 U.S.C. § 103 Rejection over Karve, Packham, and Sabo

Appellants argue that the reason stated by the Examiner for combining Sabo with the teachings of Karve and Packham in rejecting claim 5 is conclusory and is not based on an articulated reasoning (App. Br. 34-35). We disagree. As stated by the Examiner (Ans. 12, 22), translating the SMS message into voice and sending the message as a voice message is disclosed by Sabo, which enables transmission to a preferred device if it is a landline telephone (FF 11). Therefore, following the principles articulated in *KSR*, combining familiar elements according to known methods, by converting the SMS message to voice and sending the message as a voice message to a landline telephone as the preferred device, is likely to be obvious when it yields predictable results. As such, we find that Appellants have not shown error in the Examiner's position that combining Sabo with Karve and

Packham meets the step of sending the formatted message as a voice message to a phone, as recited in claim 5.

CONCLUSION

On the record before us and as discussed above, we find that Appellants have failed to show error in the Examiner's position rejecting claims 1, 4, 5, 9, and 10. In view of our analysis above, we sustain the 35 U.S.C. § 103(a) rejections of claims 1, 2, 6, 9, 10, 12, 13, 16, and 17 over Karve and Packham and of claims 3-5 and 7 over Karve and Packham, in view of Gopinath, Dehlin, Sabo, or Fostick.

ORDER

The decision of the Examiner rejecting claims 1-7, 9, 10, 12, 13, 16, and 17 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

babc

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